

Remarks/Arguments

The Rejection of Claims 1-9 under 35 USC §103

The Examiner rejected the above-identified claims under 35 USC §103 as being obvious in view of the previously cited Scanoptics reference and U.S. Patent No. 5,036,852 (Leishman) and/or Austin. More specifically, the Examiner asserted, "Scan Optics discloses a microscope stand...of a type having an electrical powered element and a standard power inlet connected to said element..., said standard power inlet rated to provide a first voltage; a standard auxiliary power outlet connected to the standard power inlet, [said auxiliary power outlet] providing a second voltage, and operatively arranged for receiving a power cord of an electrically powered auxiliary device associated with said microscope stand...wherein said standard power inlet of said microscope stand and said standard auxiliary power outlet are formed according to a common standard chosen from a plurality of standards in use throughout the world...; wherein said electrically powered element is an illumination source...and wherein said power inlet and said power outlet operatively arranged on an outer surface of said microscope stand... Scan Optics discloses the claimed invention except for said standard auxiliary power outlet providing a second voltage identical to said first voltage, explicitly stating that the power inlet, power cord and power outlet are adapted for accepting a standard International Electrotechnical Commission (IEC) Connector and wherein said power inlet comprises a male plug portion for accepting a first female outlet of said power cord and said auxiliary power outlet comprises a second female outlet for accepting a male plug portion of an auxiliary device therein." (Emphasis added). The

Examiner also asserted, "standard auxiliary female power outlets able to accept a standard IEC connector and having a second voltage matching the first voltage of a standard male power inlet also able to accept a standard IEC connector are well known to provide a receptacle for additional standard/common electrical equipment. For example, the device of Leishman...includes a standard IEC power inlet...of a first voltage and a standard IEC power outlet...of a second voltage, which is identical to the first voltage...to provide a receptacle for additional standard/common electrical equipment and wherein said power inlet comprises a male plug portion...and said auxiliary power outlet comprises a second female outlet for accepting a male plug portion of a power cord of an auxiliary device therein. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the auxiliary power outlet of Scan Optics be of identical voltage to that of said power inlet, make them both IEC compliant and a female outlet and a male plug respectively, as suggested by Leishman, to be able to power additional standard/common electrical equipment." Finally, the Examiner further asserted, "Scan Optics discloses the claimed invention except for the microscope stand being of a desktop type. Official Notice is taken that desktop type stands are well known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the stand of the Scan Optics into a desktop type to make the microscope system more compact and able to use in smaller spaces..." (Emphasis added). Applicant respectfully traverses the rejection.

First, in order to establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one having ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references teachings when combined), must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and cannot be based on the applicant's disclosure. MPEP §2143. In the present case, the prior art references cited by the Examiner do not contain a teaching, suggestion or motivation to make the combination. None of Scan Optics or Leishman disclose, teach or suggest a desktop microscope comprising an auxiliary power outlet that has a voltage identical to a power inlet. Additionally, the Examiner has not illustrated, by reference to any objective evidence, that the teaching, suggestion or motivation to combine the reference teachings emanates from that knowledge generally available to one having ordinary skill in the art at the time the invention was made. In fact, it appears more that that the teaching, suggestion and motivation to make the combination emanates from the applicant's disclosure. Thus, the present invention is nonobvious in this regard.

Second, "to support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." In the present case, the references do not expressly or impliedly suggest the claimed invention and the Examiner has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious. While the Examiner may assert "it would be

obvious to make the stand of Scan Optics into a desktop microscope stand to make the system more compact and able to fit in smaller places," to provide a convincing line of reasoning, this line of reasoning fails because the modification of the Scan Optics device as suggested by the Examiner is wholly contrary to the principles of operation of the Scan Optics device. The Scan Optics device is designed to be a "free standing" type microscope stand whereas the present invention is a desktop type stand. Additionally, Scan optics explicitly describes an auxiliary power outlet having a voltage that is different from that of the inlet voltage, which is wholly contrary to the present invention. Thus, the present invention is nonobvious in this regard as well.

Third, and in further support of Applicant's assertion above, if a proposed modification would render the prior art being modified unsatisfactory for its intended purpose, then there is no teaching, suggestion or motivation to make the proposed modification. MPEP §2143.01. Moreover, if the proposed modification or combination of references would change the very principles of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP §2143.01. Furthermore, the prior art references must be considered in their entireties, including those portions teaching away from the invention and it is improper to combine references where the reference teaches away from their combination. MPEP §2146. In the present case, the Scan Optics reference discloses a "stand up" or "free standing" microscope stand of the type typically used for surgical procedures, etc. The present invention, on the other hand, comprises a desktop type stand for use in, for example, educational laboratory settings. There are clear differences in

the structure and the use of the Scan Optics stand and desktop type stands. Indeed, as the Examiner noted, desktop type stands are well known and they are more compact and structured for use on desktop type surfaces. The Scan Optics stand, on the other hand, is not configured for use on a desktop type surface and modification thereof to a desktop type stand would render the Scan Optics stand useless for its intended purpose, e.g., performing microsurgery and the like, and/or alter the very principles of operation of the device. Additionally, the Scan Optics reference teaches away from the present invention. The Scan Optics device is a standup device whereas the present invention is a desktop type stand; Scan Optics specifically discloses an inlet having a first voltage and an auxiliary outlet comprising a second voltage whereas the present invention comprises identical inlet and outlet voltages. Thus, the Scan Optics reference is unavailable for combination and/or the present invention nonobvious in view thereof. Thus, the present invention is nonobvious in this regard as well.

In sum, heretofore, no one has proposed to combine an auxiliary power outlet with a desktop microscope stand to address the problems that occur in educational settings wherein a plurality of desktop microscopes, auxiliary devices and their respective power cords may be used by several individuals at the same time (See Applicant's specification for further description). Indeed, Scan Optics discloses a "free standing" microscope stand for use in surgical type settings and does not disclose teach or suggest desktop stands, Scan Optics does not disclose teach or suggest an auxiliary outlet comprising an voltage identical as an inlet, and Leishman relates to medical monitoring devices and does not disclose, teach or suggest microscopes or even address the problems associated with using several desktop type microscopes at the same time. There is

simply no teaching, suggestion or motivation in the references cited or in that knowledge generally available to one having ordinary skill in the art to make the claimed invention. In view of the above, the rejection should be reversed.

The Rejection of Claims 10-13 under 35 USC §103

The Examiner rejected Claims 10-13 under 35 USC §103 as being obvious in view of Scan Optics, Leishman and U.S. Patent No. 5,099,391 (Maggelet et al.). Applicant reasserts the argument made with regard to the Examiner's rejection of Claims 1-9 above.

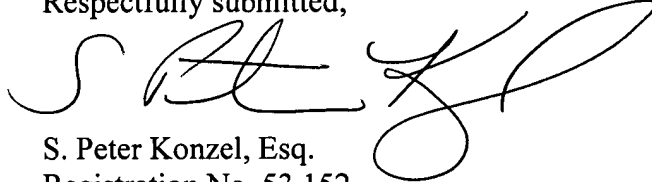
With regard to Claim 10, the Examiner has merely utilized Applicant's own disclosure and dissected the individual elements of the invention from the references to assert that the invention is obvious. Again, Scan Optics does not disclose, teach or suggest a desktop type microscope stand and does not disclose, teach or suggest a power inlet and auxiliary power outlet comprising an identical voltage; while Leishman discloses an auxiliary power outlet comprising an identical voltage as an inlet. It does not disclose, teach or suggest combining such structure with a desktop microscope; finally, Maggelet et al. do not disclose, teach or suggest microscopes. Thus the present invention is nonobvious.

Conclusion

In summary, "virtually all inventions are combinations of old elements. Therefore, an Examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue." *In re Rouffet*, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). In the present case the Examiner has merely taken individual elements from each cited reference and, absent an explicit or implicit teaching suggestion or motivation therein or in the prior art, has recombined the individual elements to render the claimed invention obvious, which is wholly in opposition with current tenets of the patent law.

In view of the above, Applicant respectfully submits that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'S. Peter Konzel', with a large, stylized flourish at the end.

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